

REMARKS

Applicants have carefully considered the September 18, 2006 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-19 are pending in this application. Claims 8-19 have been withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b).

In response to the Office Action dated September 18, 2006, claims 1, 3, 5, 6 and 7 have been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments (Fig. 8) and related discussion thereof in the written description of the specification, including page 29, lines 14-22. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Applicants acknowledge receipt of the PTO-1449 form that accompanied the September 18, 2006 Office action. The PTO-1449 was previously submitted with the Information Disclosure Statement submitted on August 4, 2006. Applicants have recently discovered that U.S. Pat. App. No. 2005/0119582 to Matsumura et al., was incorrectly listed on the PTO-1449 form as U.S. Pat. App. No. 2005/0119580. This typographical error was unintentional. Applicants, therefore, submit herewith a Supplemental PTO-1449 form which correctly identifies U.S. Pat. App. No. 2005/0119582 to Matsumura et al. The Examiner is respectfully requested to

forward Applicants an appropriately initialed copy of the supplemental PTO-1449 form with the next Office communication.

Claims 3-7 were rejected under 35 U.S.C. § 112, second paragraph. Applicants respectfully traverse the rejection. Reconsideration and withdrawal of the rejection are solicited in view of the foregoing amendments to claims and the following remarks.

Indefiniteness under the second paragraph of 35 U.S.C. § 112 is a question of law. *Tillotson Ltd. v. Walbro Corp.*, 831 F.2d 1033, 4 USPQ2d 1450 (Fed. Cir. 1987); *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). Accordingly, in rejecting a claim under the second paragraph of 35 U.S.C. § 112, the PTO is required to discharge its initial burden for providing a basis in fact and/or cogent reasoning to support the ultimate legal conclusion that one having ordinary skill in art, with the supporting specification in hand, would not be able to reasonably ascertain the scope or protection defined by the claim. *In re Cortwright*, 165 F.3d 1353, 49 USPQ 2d 1464 (Fed. Cir. 1999). Consistent judicial precedent holds that reasonable precision in light of the particular subject matter involved is all that is required by the second paragraph of 35 U.S.C. § 112. *Miles Laboratories, Inc. v. Shandon, Inc.*, 27 USPQ 2d 1123 (Fed. Cir. 1993); *North American Vaccine, Inc. v. Amercian Cyanamide Co.*, 28 USPQ 2d 1333 (Fed. Cir. 1993); *U.S. v. Telectronics, Inc.*, 8 USPQ 2d 1217 (Fed. Cir. 1988). Applicant stresses that a patent specification must be viewed through the eyes of one having ordinary skill in the art. *Miles Laboratories, Inc. v. Shandon, Inc.*, *supra*.

Claims 3 and 5 have been amended to clarify that the first and second storage devices are externally readable fro the portable electrocardiograph. Claims 6 and 7 have been amended to clarify that the radio communication device receives a given alarm signal that is transmitted by an external computer. Accordingly, one having ordinary skill in the art would not have difficulty

understanding the scope of the presently claimed invention, particularly when reasonably interpreted in light of the supporting specification. The Examiner provided no arguments to justify why one having ordinary skill in the art would have had difficulty understanding Applicant's claimed invention and the rejection is not legally viable for at least this reason. It is respectfully submitted that the imposed rejection of claims 3-7 under 35 U.S.C. § 112, second paragraph is not legally viable and hence, Applicants solicit withdrawal thereof.

Claims 1-3 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Sun et al. (U.S. Patent No. 5,861,019, hereinafter "Sun"). Applicants traverse.

Claims 1-3 have been rejected under 35 U.S.C. § 102(a) as being anticipated by Mok et al. (U.S. Pat. App. Pub. No. 2003/0109905, hereinafter "Mok"). Applicants traverse.

Applicant stresses that the factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There are significant differences between the claimed inventions and the inventions disclosed by Sun or Mok that would preclude the factual determination that Sun or Mok identically describes the claimed inventions within the meaning of 35 U.S.C. § 102.

At page 3, numbered paragraph 7 of the Office Action, the Examiner appears to consider that combination of element 30, the internal circuitry disclosed at col. 8, line 30, and reference to US 5,470,345, as allegedly corresponding to a plurality of circuit boards of claim 1.

However, the patch antenna layer 30 of Sun is an antenna. Thus, the patch antenna layer 30 cannot be considered a circuit board as claimed. In addition, the Examiner appears to consider that the ground plane layer 48 of Sun corresponds to a ground conductor layer. If the patch antenna layer 30 can not be regarded as a circuit board, the ground plane layer 48 is located outermost of a plurality of circuit elements (the internal circuitry disclosed at col. 8, lines 30 to 54). See Sun at Fig. 15. That is, Sun's ground plane layer 48 is not located between the plurality of circuit boards, as required in claim 1. Thus, Sun fails to disclose or remotely suggest a ground conductor layer provided between the plurality of circuit boards.

Moreover, claim 1 has been amended to describe, inter alia, that the ground conductor layer is disposed so that the electrocardiogram measurement device and the radio communication device are isolated from each other. This ensures that the electrocardiogram measurement device and the radio communication device are isolated from each other by the ground conductor layer during radio transmission. Consequently, the radio waves emitted from the radio communication device are reliably prevented from reaching the electrocardiogram measurement device by the ground conductor layer provided between any of the plurality of circuit boards. This results in the specific working effect of the present invention that the electrocardiogram measurement device can accurately measure an electrocardiogram based on the faint voltage generated in a human body without being affected by the radio waves emitted from the radio communication device.

With respect to the Mok reference, the Examiner appears to consider that the reference strip 21 of Mok corresponds to a ground conductor layer. In Mok, the reference strip 21 is located between the sensor substrate 29 and the substrate 27 provided on the sensor substrate 29. See paragraphs [0037] to [0041] and Fig. 3. Applicants submit that the reference strip 21 of Mok

has a smaller area than those of the sensor substrate 29 and the substrate 27 and, therefore, cannot isolate the sensor 29 and the substrate from each other. Accordingly Mok fails to disclose or suggest a ground conductor layer that is disposed so that the electrocardiogram measurement device and the radio communication device are isolated from each other.

The above argued differences between the claimed device and the applied art undermines the factual determination that either Sun or Mok discloses the portable electrocardiograph identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 U.S.P.Q. 86 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejections of claims 1-3 under 35 U.S.C. § 102 for lack of novelty as evidenced by Sun or Mok are not factually viable and, hence, solicit withdrawal thereof.

Dependent claims 4-7 have been rejected under 35 U.S.C. § 103 as being unpatentable over Sun. Applicants respectfully traverse.

Dependent claims 4-7 have been rejected under 35 U.S.C. § 103 as being unpatentable over Mok. Applicants respectfully traverse.

Applicant incorporates herein the arguments previously advanced in traversal of the rejection of claims 1-3 under 35 U.S.C. § 102 predicated upon Sun or Mok. Dependent claims 4-7 are free from the applied art in view of their dependency from independent claim 1.

Accordingly, it is believed that all pending claims are now in condition for allowance. Applicant therefore respectfully requests an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or

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an Examiner's amendment, the Examiner is invited to call Applicant's representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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